UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,081	12/16/1999	JOHN L. BEEZER	3797.84608	8435

28319 7590 04/21/2003

BANNER & WITCOFF LTD.,
ATTORNEYS FOR MICROSOFT
1001 G STREET , N.W.
ELEVENTH STREET
WASHINGTON, DC 20001-4597

EXAMINER
BIENEMAN, CHARLES A

ART UNIT	PAPER NUMBER
2176	9

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/465,081	Applicant(s) BEEZER ET AL.	
	Examiner Charles A. Bieneman	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/16/99, 8/15/01, and 10/9/01* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17,19-28 and 30-34* is/are rejected.

7)☒ Claim(s) *18 and 29* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6 and 8* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. This action is responsive to the following communications: original application filed on December 16, 1999 and Information Disclosure Statements filed on August 15, 2001 and October 9, 2001.

2. Claims 1-34 are pending. Claims 1, 15, 28, and 32 are independent claims.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
(1) It does not identify the citizenship of each inventor; and
(2) It is signed by three inventors but the signature blocks for the latter two inventors identify them as the 3rd and 4th inventors respectively.

Specification

4. The attempt to incorporate subject matter into this application by reference to www.openbook.org at lines 13-15 on page 3 of the specification is improper because, as stated in MPEP 608.01(p), "hyperlinks and/or other forms of browser executable code cannot be incorporated by reference." Correction is required.

5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code at lines 10-14 on page 2. (The link examples on pages 12 and 15 are not objected to because they would not be executed by a standard browser.) Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

6. **Claim 1** is objected to because of the following informalities: the word "indication" in line 3 should be preceded by an article. Appropriate correction is required.

7. **Claims 15 and 28** are objected to because of the following informalities: the comma in line 3 of each claim is unnecessary. Appropriate correction is required.

8. **Claim 28** is objected to because of the following informalities: in line 7, it appears that "identified" should read "identifies". Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claims 13 and 26** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Inasmuch as these claims recite that "the pre-defined system command is an applet" one skilled in the art would not have understood how to implement the recited language because an applet, a computer program, is not something which could have been a command; rather, a command could have invoked an applet.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. **Claims 13 and 26** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Inasmuch as these claims recite that "the pre-defined system command is an applet" they do not make sense because an applet, a computer program, is not something which could have been a command; rather, a command could have invoked an applet.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. **Claims 1-17, 19, 21-28, 30, 32, and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,288,716 B1 to Humpleman et al., issued September 11, 2001, filed June 24, 1998 in view of U.S. Patent Number 6,449,640 B1 to Haverstock et al., issued September 10, 2002, filed June 19, 1998. With respect to the rejection of each dependent claim below, the preceding rejection(s) of the relevant base claim(s) is incorporated therein.

Regarding **independent claim 1**, Humpleman et al. teach (a) receiving indication that a link in the document has been selected, as well as identifying and executing a predefined system command as recited in steps (c) and (d). (Humpleman et al., col. 7, lines 41-46.)

Humpleman et al. do not teach (b) locating an alias within a link or that the system command recited in steps (c) and (d) is associated with an alias. However, Haverstock et al. teach that the benefits of using aliases for objects accessed via links include avoiding the problem of having the link broken when object or file names change. (Haverstock et al., col., 5, lines 15-44.) Because the system commands recited by applicants are accessed via links in a way analogous to the accessing of objects with links taught by Haverstock et al., one of ordinary skill in the art would have understood that the benefits taught by Haverstock et al. applied to system commands accessed via links. Therefore, it would have been obvious to one of ordinary skill in the art to have modified Humpleman et al. with Haverstock et al. and to have located an alias within a link and to have identified and executed a system command associated with the alias.

Regarding **independent claim 15**, Humpleman et al. teach (a) a link embedded within the file that can be selected by a user viewing the markup language file. (Humpleman et al., col. 7, lines 41-46.)

Further, Humpleman et al. do not teach an alias within a link that identifies a predefined system command but they do teach enabling a computing system to execute the predefined system command when a user has selected the link. (Humpleman et al., col. 7, lines 41-46.) Moreover, Haverstock et al. teach that the benefits of using aliases for objects accessed via links include avoiding the problem of having the link broken when object or file names change.

(Haverstock et al., col., 5, lines 15-44.) Because the system commands recited by applicants are accessed via links in a way analogous to the accessing of objects with links taught by Haverstock et al., one of ordinary skill in the art would have understood that the benefits taught by Haverstock et al. applied to system commands accessed via links. Therefore, it would have been obvious to one of ordinary skill in the art to have modified Humpleman et al. with Haverstock et al. and to have located an alias within a link that identified a predefined system command and enabled a computing system to execute the predefined system command when a user has selected the link.

Regarding **independent claim 28**, Humpleman et al. teach (a) a link embedded within the file that can be selected by a user viewing the file. (Humpleman et al., col. 7, lines 41-46.)

Further, Humpleman et al. inherently teach (b) an instruction in the link to invoke a predefined system command inasmuch as Humpleman et al. teach identifying and executing a system command after a link is selected as discussed above regarding claim 1, and it would not have been possible to identify and execute a system command unless there was an instruction in the link to invoke a predefined system command.

Further, Humpleman et al. do not teach an alias within a link that identifies a predefined system command but they do teach enabling a computing system to execute the predefined system command when a user has selected the link. (Humpleman et al., col. 7, lines 41-46.) Moreover, Haverstock et al. teach that the benefits of using aliases for objects accessed via links include avoiding the problem of having the link broken when object or file names change. (Haverstock et al., col., 5, lines 15-44.) Because the system commands recited by applicants are accessed via links in a way analogous to the accessing of objects with links taught by Haverstock

et al., one of ordinary skill in the art would have understood that the benefits taught by Haverstock et al. applied to system commands accessed via links. Therefore, it would have been obvious to one of ordinary skill in the art to have modified Humpleman et al. with Haverstock et al. and to have located an alias within a link that identified a predefined system command and enabled a computing system to execute the predefined system command when a user has selected the link.

Regarding **independent claim 32**, Humpleman et al. inherently teach (a) an operating system capable of performing a plurality of system commands inasmuch as Humpleman et al. teach use of servers and further teach that "a server typically includes a custom, built-in, control program to implement control of its own hardware." (Humpleman et al., col. 5, lines 45-46.)

Further, Humpleman et al. teach (b) a markup language document stored in a memory device that is accessible by the system, the mark-up language document having at least one link that references a predefined system command (Humpleman et al., col. 7, lines 41-46), although Humpleman et al. do not teach that the system command has an alias. However, Haverstock et al. teach that the benefits of using aliases for objects accessed via links include avoiding the problem of having the link broken when object or file names change. (Haverstock et al., col., 5, lines 15-44.) Because the system commands recited by applicants are accessed via links in a way analogous to the accessing of objects with links taught by Haverstock et al., one of ordinary skill in the art would have understood that the benefits taught by Haverstock et al. applied to system commands accessed via links. Therefore, it would have been obvious to one of ordinary skill in the art to have modified Humpleman et al. with Haverstock et al. and to have had the system command use an alias.

Further, Humpleman et al. teach (c) an application program running on the operating system for displaying the markup language document and invoking the predefined system command when the link is selected by a user. (Humpleman et al., col. 6, line 63 – col.. 7, line 3: "The HTML files define the control and command functions associated with a particular home device. Each HTML file may also contain embedded references to other HTML files. The browser based DTV 102 (acting as a client), receives and interprets the HTML files associated with the home devices (acting as servers) and graphically displays the respective control and command information on its viewable display.")

Regarding **dependent claim 2**, Humpleman et al. discloses a computer-readable medium having computer-executable instructions. (Humpleman et al., col. 6, line 66 – col. 7, line 3).

Regarding **dependent claim 3**, Humpleman et al. disclose that the computer-executable instructions are within an application program inasmuch as it discloses they are in a web browser. (Humpleman et al., col. 6, line 66 – col. 7, line 3).

Regarding **dependent claim 4**, Humpleman et al. teach (e) in response to the step of executing, revising the first content of the link to display a second content. (Humpleman et al., col. 16, lines 5-9: "After a device image 712 is selected, the session manager continues to display the contents of the device link page 710. However, in certain embodiments, the selected device button 712 is deactivated and is, therefore, non-responsive for further selection by the user.")

Regarding **dependent claim 5**, the rejection of claim 2 above is fully incorporated herein.

Regarding **dependent claims 6 and 17**, Humpleman et al. inherently teach reading an instruction in the link and identifying and executing a system command inasmuch as Humpleman et al. teach identifying and executing a system command after a link is selected as

discussed above regarding claim 1, and it would not have been possible to identify and execute a system command unless an instruction in the link to do so had been read.

Regarding **dependent claim 7**, the rejection of claim 2 above is fully incorporated herein.

Regarding **dependent claims 8 and 21**, Humpleman et al. teach that the predefined system command is selected from, among other things, networked operations. (Humpleman et al., col. 3, lines 6-8.)

Regarding **dependent claims 9 and 22**, Humpleman et al. teach that the predefined system command is selected from, among other things, networked Brightness. (Humpleman et al., col. 8, lines 9-16.)

Regarding **dependent claims 10 and 23** , Humpleman et al. do not explicitly disclose the predefined system command consisting of either Network Lookup or Network Search. However, Humpleman et al. do teach that the predefined system command can be a request for a program guide. (Humpleman et al., col. 23, lines 51-59.) One of ordinary skill in the art would have recognized that a user might find it easier to search for a specific program rather than scanning the entire program guide to see if and when the program was scheduled. Therefore, it would have been obvious to one of ordinary skill in the art to have the predefined system command consist of Network Search.

Regarding **dependent claims 11 and 24**, Humpleman et al. teach that the predefined system command consists of Form Post. (Humpleman et al., col. 8, lines 16-18: "For action local to the DTV, the DTV thus may include a server capability, to interpret the post actions from the browser.")

Regarding **dependent claims 12 and 25**, Humpleman et al. do not explicitly teach the predefined system command consisting of Load Value. However, one of ordinary skill in the art would have recognized the desirability of loading a value to be used the next time a predefined system command was invoked because one of ordinary skill would have known that this would give the system a greater ability to be flexible and dynamic in carrying out system commands. Therefore, it would have been obvious to one of ordinary skill in the art to have the predefined system command consist of Load Value.

Regarding **dependent claims 13 and 26**, Humpleman et al. do not teach that the predefined system command is an applet for a third party application, although they do teach interfaces written in Java, well known to be the programming language for applets. (Humpleman et al., col. 4, line 29.) Moreover, third party applications running as applets in standard web browsers were well known at the time of the claimed invention, as were the benefits of portability and added functionality over the web that applets provided. Therefore, it would have been obvious to one of ordinary skill in the art to have the predefined system command be an applet for a third party application.

Regarding **dependent claims 14 and 27**, Humpleman et al. teach that the markup language document is an HTML document. (Humpleman et al., col. 4, lines 36-40.)

Regarding **dependent claim 16**, Humpleman et al. do not disclose that the alias is an integer. However, it was well known in the art at the time of to claimed invention to use integers for identifying commands because the integer data type could be stored and transmitted more efficiently than, for example, a string containing a command or command name. Therefore, it would have been obvious to one of ordinary skill in the art to make the alias an integer.

Regarding **dependent claims 19 and 30**, Humpleman et al. do not teach a table comprising a plurality of aliases and a corresponding predefined system command for each of the aliases. However, Haverstock et al. teach maintaining in a database information relating to identifiers and corresponding objects. (Haverstock et al., col. 5, lines 7-11.) Moreover, use of relational tables was well known in the art and one of ordinary skill in the art would have known that such relationships are frequently stored in tables because tables provide an efficient means of storing and accessing such relationships. Therefore, it would have been obvious to one of ordinary skill in the art to have a table comprising a plurality of aliases and a corresponding predefined system command for each of the aliases.

Regarding **dependent claim 34**, the rejection of claims 19 and 30 above is fully incorporated herein.

Further, Humpleman et al. do not teach that the table is stored in a second memory device but this limitation would have been obvious to one of ordinary skill in the art because one of ordinary skill would have recognized that the table should be kept in a central remote location so that it could be centrally updated and so that all devices accessing it would receive the same information.

16. **Claims 20, 31, and 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Humpleman et al. in view of Haverstock et al. and further in view of the admitted prior art ("APA") on page 3 of applicants' specification.

Neither Humpleman et al. nor Haverstock et al. teach that the markup language file is an e-book. However, the APA teaches both that it was known to format e-books with a markup language and to view them on computer-based display devices. One of ordinary skill in the art

would have recognized that making the markup language file an e-book would have conferred the benefits of allowing the display of the e-book to be adjusted via the simple and direct method of accessing links. Therefore, it would have been obvious to one of ordinary skill in the art to make the markup language file an e-book.

Allowable Subject Matter

17. **Claims 18 and 29** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the examiner reads these claims to require that the instruction comprise the specific string "X-MSR1INVOKE", and has located no prior art references teaching or suggesting that the instruction is this specific string.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent or Pub. Number	Name	Issue or Pub. Date	File Date	
2002/0059402 A1	BELANGER	5/16/02	8/14/98	
6,192,415 B1	Haverstock et al.	2/20/01	6/19/98	
6,139,177	Venkatramen et al.	10/31/00.	4/25/97	
5,982,445	Eyer et al.	11/9/99	10/21/96	
5,956,483	Grate et al.	9/21/99	6/28/96	

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Bieneman whose telephone number is 703-305-8045. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

CAB
April 7, 2003

HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100